UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,886	09/04/2003	Kimmo Laakkonen	915-006.021	1554

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EXAMINER
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ART UNIT	PAPER NUMBER
2448	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/656,886	LAAKKONEN, KIMMO
	Examiner	Art Unit	
	BRIAN P. WHIPPLE	2448	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 January 2011</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,2,4-6,9,14-18 and 21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,2,4-6,9,14-18 and 21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-2, 4-6, 9, 14-18 and 21 are pending in this application and presented for

examination.

2.   Applicant's argument, see page 8, filed 1/25/11, with respect to the 35 U.S.C. 101

rejection, has been fully considered and is persuasive. The 35 U.S.C. 101 rejection of claim 9

has been withdrawn.

3.   Applicant's remaining arguments filed 1/25/11 have been fully considered but they

are not persuasive.

4.   As to claim 1, the applicant argues the recipient's system fails to select the profile, but

only receives the profile. The examiner respectfully disagrees. Baker discloses the user selects

a privileged email for display ([0067], ln. 5-12). Baker goes on to disclose the client's system

can be utilized to access the underlying privilege profile in the selected email ([0069]). The

client's system must access and utilize the underlying privilege profile it has received, as was

discussed in the previous Office action mailed on 7/20/10 (Baker: [0042], the user profile may

be "packaged with the e-mail" and therefore will be present on the recipient's system when it

receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-

16, the executable module governs the access rights of the device accessing the e-mail). The

access and utilization of the privilege profile received is a selection of the profile by the

client's system. The claim language does not require an active selection by the end user from

a plurality of options.

5.   Further regarding claim 1, the applicant argues Baker discloses a recipient based filter

as opposed to a sender based filter. The applicant equates a sender based filter to one that

filters out email based on the sender of the email. However, such an interpretation of the

claim language is not required by the claim language itself. The examiner maintains that a

filter selected by a sender is a "sender based filter" as the filter is based upon the

configuration performed by a sender (Baker: [0075] – [0076]; the sender of an e-mail creates

access rights for the e-mail in a "privileged profile" that is included with the e-mail after it is

sent as an executable module).

6.   Finally regarding claim 1, the applicant argues Baker does not disclose filter

characteristics, but rather encryption techniques used to prevent a user from viewing an

email. The examiner respectfully disagrees with the applicant's interpretation. Similar to the

discussion of claim language in the preceding paragraph, the examiner does not agree with

the applicant, as the examiner believes the broadest reasonable interpretation of filter may

include a user being prevented from viewing certain emails as defined by access rights

(Baker: [0079], ln. 10-16, the executable module governs the access rights of the device

accessing the e-mail and filters in ways such as rendering a user "unable to view the e-mail")

or a user receiving a filtered list of possible recipients for an email (Baker: [0071]). In other

words, the user's ability to perform certain actions is filtered out from all potential actions (as

they relate to access rights).

7.   The remainder of the claims are argued to be allowable in relation to claim 1 above,

but the examiner has refuted the alleged allowability of claim 1. Therefore, the remainder of

the claims are not allowable due solely to their relation to claim 1.

Claim Rejections – 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

9.   Claims 1-2, 4-6, 9, 14-18, and 21, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Theimer et al. (Theimer), U.S. Patent No. 5,493,692, in view of Baker et al.

(Baker), U.S. Publication No. 2004/0049696 A1.

10.   As to claim 1, Theimer discloses a method for controlling the handling of push type e-

mails on a mobile terminal device (Abstract), comprising:

        selecting a user profile (Col. 25, ln. 17-26) on the basis of automatically received

position information of said mobile terminal device (Abstract; Col. 8, ln. 52-58; Col. 9, ln. 64

– Col. 10, ln. 7, "user's context and environment, such as current location… user's

preferences may be dynamically changed by… changing the profile"; Col. 25, ln. 27-45), said

user profile regarding the handling of push type e-mails on said mobile terminal device (Col.

25, ln. 17-26, 46-51, and 55-57), wherein said selected user profile comprises push type e-

mail enabled or push type e-mail disabled (Abstract; Col. 25, ln. 17-26, 46-51, and 55-57; in

order to deliver e-mail, when and where appropriate, the display device receiving the e-mail

must have push type e-mail enabled by the activation of necessary hardware and software

components required to receive push type e-mails in the display device; the limitation refers

to the "enabled... or disabled" in the alternative only and therefore any combination of

enabled and/or disabled properly rejects the claim, in this case the enabled scenario has been

cited),

controlling at said mobile terminal device (Col. 25, ln. 55-57; "a user may specify…")

the handling of push type e-mails according to said selected user profile (Col. 25, ln. 46-51),

comprising enabling push type e-mail or disabling push type e-mail by activating or

deactivating of a hardware or software component required to receive push type e-mails in

the mobile terminal device (Abstract; Col. 25, ln. 17-26, 46-51, and 55-57; in order to deliver

e-mail, when and where appropriate, the display device receiving the e-mail must have push

type e-mail enabled by the activation of necessary hardware and software components

required to receive push type e-mails in the display device; the limitation refers to the

"enabling… or disabling" and "activating or deactivating" in the alternative only and

therefore any combination of enabling and/or disabling and activating and/or disabling

properly rejects the claim, in this case the enabling and activating have been cited).

Theimer is silent on selecting a user profile stored in said mobile terminal device,

filtering received push type e-mail received by the mobile terminal device according

to a sender based filter characteristic selection, wherein the filter characteristics are defined

in said selected user profile, and

storing at least one filtered push type e-mail of the received push type e-mail in a

manner not visible to said selected user profile when the at least one filtered push type e-

mail does not pass the filter characteristics of said selected user profile.

However, Baker discloses selecting a user profile stored in said mobile terminal device ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-16, the executable module governs the access rights of the device accessing the e-mail),

filtering received push type e-mail received by the mobile terminal device according to a sender based filter characteristic selection([0075]; [0076]; the sender of an e-mail creates access rights for the e-mail in a "privileged profile" that is included with the e-mail after it is sent as an executable module), wherein the filter characteristics are defined in said selected user profile ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail; [0079], ln. 10-16, the executable module governs the access rights of the device accessing the e-mail and filters in ways such as rendering a user "unable to view the e-mail"), and

storing at least one filtered push type e-mail of the received push type e-mail in a manner not visible to said selected user profile when the at least one filtered push type e-mail does not pass the filter characteristics of said selected user profile ([0042], the user profile may be "packaged with the e-mail" and therefore will be present on the recipient's system when it receives the e-mail; [0078], an executable module is included with the e-mail;

[0079], ln. 10-16, the executable module governs the access rights of the device accessing the

e-mail and filters in ways such as rendering a user "unable to view the e-mail").

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Theimer in the aforementioned manner as taught by

Baker in order to include access rights for an e-mail with the e-mail itself, so that it may be

stored on each recipient, thereby enforcing the sender's desired access rights at each

recipient.

11.   As to claim 2, Theimer and Baker disclose the invention substantially as in parent

claim 1, including said controlling of the handling of push type e-mails comprises notifying a

push type e-mail server of a mobile communication network about the handling of push type

e-mails according to said determined user profile (Theimer: Fig. 1; Fig. 17; Col. 24, ln. 49-60).

12.   As to claim 4, Theimer and Baker disclose the invention substantially as in parent

claim 1, including said user profile comprises a predetermined filter acting on the received

push type e-mails (Theimer: Col. 25, ln. 23-26 and 52-57), said filter selecting push type e-

mails according to properties of said received emails (Theimer: Col. 25, ln. 23-26 and 52-57),

wherein said method further comprises:

receiving a push type e-mail (Theimer: Col. 25, ln. 6-12), and

filtering said received e-mail according to said properties (Theimer: Col. 25, ln. 23-26

and 46-57).

13.   As to claim 5, Theimer and Baker disclose the invention substantially as in parent

claim 2, including storing said received push type e-mail (Theimer: Fig. 17, items 430, 432,

and 436; Col. 25, ln. 46-51; it may be interpreted that if the application waits for a change in

context before reattempting delivery that it must store the e-mail until the reattempt)

14.   As to claim 6, Theimer and Baker disclose the invention substantially as in parent

claim 1, including said terminal device further comprises sensors (Theimer: Fig. 1; Col. 12, ln.

62-66), said method further comprising:

      determining of sensor data (Theimer: Fig. 1; Col. 12, ln. 62-66), and

      changing said user profile according to said determined sensor data (Theimer: Fig. 1;

Col. 9, ln. 64 – Col. 10, ln. 7; Col. 12, ln. 62-66; Col. 25, ln. 17-26).

15.   As to claims 9 and 14-15, the claims are rejected for reasons similar to claim 1 above.

16.   As to claim 16, the claim is rejected for reasons similar to claim 4 above.

17.   As to claim 17, the claim is rejected for reasons similar to claim 2 above.

18.   As to claim 18, the claim is rejected for reasons similar to claim 6 above.

19.   As to claim 21, the claim is rejected for reasons similar to claims 1-2 above.

Conclusion

20.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened

statutory period will expire on the date the advisory action is mailed, and any extension fee

pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS

from the mailing date of this final action.

21.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-

1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free). If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or

571-272-1000.

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